

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHIIYA YAMADA, SATOSHI ASANO
and HIROTAKA TOMIZAWA

Appeal No. 2000-2110
Application 08/945,705

ORDER REMANDING TO EXAMINER

MAILED

OCT 17 2001

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Applicants filed an Appeal Brief (Paper No. 13) on April 6, 1999. At page 2 of this Appeal Brief, applicants state:

Incidentally, had the Examiner entered appellants' last amendment to claim 2, section (b) of that claim would be identical to section (b) of claim 1 and the obvious typographical errors appearing in the last paragraph of claim 2 would have been corrected. (Appellants proposed wording of claim 2 is set forth in "Corrected Claims on Appeal".)

The "Corrected Claims on Appeal" appear on pages 7 and 8 of the Appeal Brief. Confusion exists if the "Corrected Claims on Appeal" are a proposed amendment for correction of "obvious typographical errors" or an addendum to the Appeal Brief. If

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applicants were attempting to submit an amendment, the examiner should then notify applicants that the proper procedure to submit an amendment, is to submit the amendment in a separate paper from the Appeal Brief. This amendment should include underlines and brackets. See 37 CFR § 1.121 (1998).

In the Examiner's Answer (Paper No. 14, mailed June 14, 1999) at Section (10) Grounds of Rejection, the examiner inappropriately refers back to two previous office actions Paper Nos. 5 (Office Communication, mailed June 4, 1998) and 8 (Final Rejection, mailed December 17, 1998) for the exposition of the rejections on appeal. As clearly stated in the Manual of Patent Examining Procedure (MPEP) § 1208 (7th Ed., July 1998) at page 1200-15, an examiner may incorporate in the answer only those statements of the grounds of rejection which appeal in a single prior office action. Compliance with MPEP § 1208 concerning the Grounds of Rejection in the Examiner's Answer is required.

Accordingly, it is

ORDERED that the application is remanded to the examiner for resolution of the following issues:

- clarification the status of the "Corrected Claims on Appeal" located in the Appendix of the Appeal Brief (Paper No. 13, filed April 6, 1999);

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- if appropriate, notification to applicants of the proper procedure to submit an amendment in proper format on a separate paper from the Appeal Brief;

- compliance with MPEP § 1208 with the examiner's answer (Paper No. 14) concerning the grounds of rejection;

- for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

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A large, stylized handwritten signature in black ink, likely belonging to Dale M. Shaw, is written over a horizontal line.

DALE M. SHAW
Program and Resource Administrator
(703) 308-9797

DMS:svt

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EXXON RESEARCH AND ENGINEERING COMPANY
P.O. Box 390
Florham Park, NJ 07932-0390